

Appln. No.: 09/273,021
Amdt. Dated: September 30, 2003
Reply to Office Action of July 2, 2003

REMARKS

Claim 1, 3, 10, 19 and 20 remain in the application with claims 1, 19 and 20 being independent.

The claims have been amended to comport with the Examiner's concern that the headings recited in the claims are not of the precise wording set forth in the MPEP. The headings are meant to cover all equivalents of expressing the particular section of the application. Applicant, in fact, uses the headings suggested by the MPEP, albeit with slightly different words but with the same meaning. Granted, applicant does not claim all of the headings as all of the headings are not always necessary, *e.g. RELATED APPLICATIONS, FEDERAL RESEARCH, COMPACT DISC, or SEQUENCE LISTING*. Additional headings may be added but applicant is outlining the subject areas to be composed in an application.

Reconsideration of the previous rejection as being obvious over Takano in view of Nehab (US 6,029,182), Simpson (Mastering WordPerfect 5.1 & 5.2 for Windows™) and the MPEP to avoid an appeal is respectfully requested.

The standards by which the claims in this application are to be judged are set forth in the MPEP:

2143.03 All Claim Limitations Must Be Taught or Suggested [R-1]

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim

depending therefrom is nonobvious. *In re Fine*, 837, F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

2142 Legal Concept of *Prima Facie* Obviousness [R-1]

. . . The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness . . .

ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §243 - §2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The following recitations in the claims are admittedly not suggested in Takano or any of the other references:

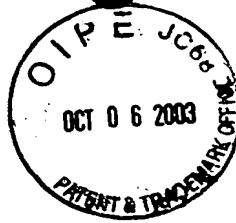
1. Storing a duplicate set of claims. . . and creating a description by retrieving the duplicate set of claims under the "DESCRIPTION"
2. Searching for and replacing "said" with - -the- -in the description.

3. Storing element names . . . and searching for each element name in order of first occurrence and assigning successive reference numbers to the element names throughout the description beginning above the highest figure number.
4. Automatically shifting the reference numbers in response to a change in order of first occurrence in the description.
5. Alternative phrasing of the clauses of the duplicate set of claims in the description.
6. Selecting and storing ABSTRACT sentences.

What the Examiner appreciates is that the patent or pieces thereof are known but what is not appreciated is that applicant has developed a new combination to produce a patent. The steps applicant has developed produces the most efficient method of identifying, distinctly claiming and thereafter composing a patent application. Just because the finished product is known or nearly known, does not mean that a specific combination of steps to produce that product are obvious. To the contrary, there is not one suggestion of the steps set forth above in paragraphs 1-6, let alone a suggestion to combine them. In other words, the Examiner admits the limitations set forth above in paragraphs 1-6 are not found in the prior art and absent a suggestion of same, these limitations can not simply be deemed "obvious".

Accordingly, in accordance with the MPEP, the claims are now presented in condition for allowance, which allowance is respectfully solicited. Applicant believes that no fees are due, however, if any become required, the Commissioner is hereby

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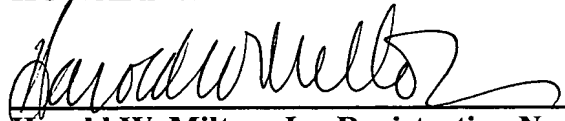


authorized to charge any additional fees or credit any overpayments to Deposit Account 08-2789. Further and favorable reconsideration of the outstanding Office Action is hereby requested.

Respectfully submitted

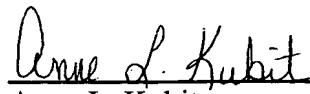
HOWARD & HOWARD ATTORNEYS, P.C.

9/30/03
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CERTIFICATE OF MAILING

I hereby certify that this **Amendment** for U.S. Serial No.: 09/273,021 filed March 19, 1999 is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on **September 30, 2003**.


Anne L. Kubit